SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1967.

No. 1181

CHESTER WAGNER, AN INDIVIDUAL, and HENNY PENNY CORPORATION,

Petitioners,

vs.

BALLANTYNE INSTRUMENTS & ELECTRONICS, INC.,

Respondent.

BRIEF FOR RESPONDENT OPPOSING PETITION FOR WRIT OF CERTIORARI.

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March 29, 1968.

THE BURTHORP-WARREN PRINTING COMPANY, CHICAGO

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To The Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Respondent submits this Brief in opposition to the Petition for Writ of Certiorari to show that the Petition presents no ground which justifies the granting of the Writ.

OPINIONS BELOW.

The Opinion of the Court of Appeals for the Sixth Circuit (Supp. App. to Petition, p. 3) holding Claim 1 of Wagner Patent No. 2,778,736 "invalid" is reported at 345 F. 2d 671 (1965), and its Opinion (App. A of Petition) holding patent Claims 2 and 3 "not infringed" by Defendant is reported at 386 F. 2d 789 (1967). Only the latter opinion is involved in the Petition.

JURISDICTION.

The jurisdictional requisites are set forth in the Petition.

QUESTION PRESENTED.

The Petition sets forth two questions upon which review is sought. These concern the technical doctrines of equivalents and file wrapper estoppel, neither one of which was discussed by the Court of Appeals in its opinion affirming the District Court. Since the holding of non-infringement is supported by several findings of fact, it is submitted that the question should be presented as follows:

Should the Supreme Court exercise its certiorari jurisdiction in a case:

(a) where the patent monopoly relates to a mere recipe or method of deep fat pressure cooking of food, and

(b) where the Court of Appeals held that the findings of non-infringement "are supported by substantial evidence" and

(c) where the file wrapper estoppel applied by the District Court followed the standards consistently laid down by the Supreme Court as well as the lower courts

such that there is no conflict of decisions or unsettled federal question here involved?

STATEMENT.

Since only a cooking recipe is involved, the facts of this patent case are relatively simple. They should be reviewed, however, so that the question presented here can be understood in its proper context.

Wagner patent 2,778,736 is directed to a METHOD OF DEEP FAT COOKING FOODS UNDER PRESSURE and a recipe having these two cooking steps:

> (1) introducing the food to be cooked into a bath of hot oil heated to 310° F.-325° F. and allowing it to cook for a time sufficient to brown the food, and
>
> (2) thereafter enclosing the same and continuing the cooking under a pressure of up to about 15 pounds per square inch for a period of time to cook the food. (Supp. App. to Petition, p. 4.)

The first cooking step is a preliminary browning step with the cooking pot open to the atmosphere. The second cooking step requires the cooking pot to be closed so that a pressure of 15 pounds per square inch can be maintained. The patent states that for an average size 1½ pound chicken, the first step takes 2 to 3 minutes and the second step takes 5 to 7 minutes.

When the patentee, Wagner, first filed his patent application in the Patent Office, he presented broad claims which covered only the final pressure cooking step and which did not include the limitation of a preliminary browning step prior to the pressure cooking step. These unduly broad claims were rejected by the Patent Office as follows:

> "Claims 22-24 are rejected as failing to define applicant's process since they do not recite the initial step of partially cooking the food in hot oil for a period of 2-3 minutes before enclosing the food and continuing the cooking of the food under pressure while the food

is maintained in the bath of hot oil. It is axiomatic that the claims must be commensurate in scope with the disclosure." (Supp. App. to Pet., p. 12.)

Wagner acquiesced in this Patent Office rejection by cancelling his broad one-step cooking claims and presenting new, narrowed claims which were ultimately granted to become the claims of his issued patent. Each of these new claims expressly included both (1) the initial browning step and (2) the final pressure cooking step required by the Patent Office as material limitations necessary to overcome the rejection and to induce the allowance of the claims. (Supp. App. to Pet., p. 12.)

More than two years after the issuance of his patent with these narrowed claims, Wagner sought to re-issue his patent by presenting new claims 4-7 again covering only the final pressure cooking step. These new claims did not define the preliminary browning step and, if allowed, would have covered the operation of closing the lid of the pot for pressure cooking as soon as all of the food was loaded therein. (Supp. App. to Pet., p. 13.) The Patent Office again rejected Wagner's attempt to obtain such unduly broad claims:

> "Claims 4-7 are rejected as involving new matter and based upon an inadequate disclosure in the instant application since there is no specific basis for the following limitations . . . the concept of browning and cooking the meat in one operation. No antecedent basis is found in the instant application . . . for carrying out the browning and cooking of the meat in one operation. (R. 251ja, 252ja.)

Wagner acquiesced in the Patent Office refusal of claims not expressly limited to his two step cooking method and he allowed his re-issue application to become abandoned. (Supp. App. to Pet., p. 13.)

The District Court found that the Respondent has not infringed Wagner's two-step cooking method, but, to the contrary, has always caused the lid to be closed for pressure cooking *immediately* after all of the food is placed in the hot oil. (Supp. App. to Pet., p. 13.) The preliminary browning step, so essential to the allowance of the Wagner patent claims, has never been used by Respondent. The Court of Appeals held that such findings of non-infringement were "supported by substantial evidence". (App. A of Pet., p. 19.)

ARGUMENT.

The issue presented by the Petition concerns a narrow point of patent law which is only ancillary to the main issues of this case. Petitioners' asserted question does not warrant review by this Court on certiorari and particularly where no conflict of decision or unsettled question of federal law exists.

The opinion of the District Court and the affirming opinion of Court of Appeals relating to non-infringement could not have been more clearly expressed—the patent monopoly covers only a two-step cooking method and Respondent uses only a one-step cooking method. Since the patent claims do not cover respondent's recipe, there can be no infringement and the decision below clearly is correct.

I.

PETITIONERS ARE ESTOPPED TO RECAPTURE THE CANCELLED CLAIMS AND CANNOT MAKE THE PATENTED TWO STEP COOKING METHOD THE EQUIVALENT OF RESPONDENT'S ONE STEP COOKING METHOD.

The first point asserted by Petitioners is that they should not be denied a broad interpretation of the patent claims merely because Wagner complied with the Patent Statute in distinctly claiming the invention. (Pet., p. 2.) This assertion is a nimble reversal of the actual point here which is whether Petitioners should be permitted to interpret the issued patent claims so as to convert them back into their original indefinite and abandoned form.

Section 112 of Title 35, United States Code, requires the patent claim to particularly point out and distinctly claim

the disclosed invention. (Pet., p. 2.) Since the Wagner Patent application disclosed only a two-step method having a preliminary browning step and a final pressure cooking step, the Patent Office rejected all of the initially presented claims which covered only one cooking step and which were not "commensurate in scope with the disclosure". (Supp. App. to Pet., p. 12.) Wagner cured this indefiniteness and failure to meet the statutory requirements by abandoning the one-step method claims and by presenting new claims expressly limited to his disclosed two-step method.

Petitioners now make the wholly illogical argument that because Wagner was made to comply with the statute requiring distinct claiming of the invention, they now should be permitted under the doctrine of equivalents to interpret the two-step method claims to cover Respondent's single step method. Manifestly, if Petitioners were allowed to do this, these claims would revert back to their original indefinite scope—and the statutory requirement would again be violated.

The opinions below correctly held that as a result of their Patent Office prosecution of Wagner patent, Petitioners are estopped to revive the rejected and cancelled one-step method claims and restore them to the Wagner patent (Supp. App. to Pet., p. 13). In the second point raised by the Petition (Pet., p. 2), Petitioners assert that file wrapper estoppel should be applied only where the claims have been amended to overcome the prior art and should not be applied where such amendment is made to overcome a rejection based upon a violation of the Patent Statute requiring the claim to be definite and to particularly point out the disclosed invention. (Pet., p. 11.) There is no basis in any prior Supreme Court decision for this alleged distinction, and there is no conflict of decisions among the lower Courts on this point. The cases relied upon by Petitioners are distinguishable both in fact and in their application of the law from the position being urged by Petitioners.

II.

THE DOCTRINES OF EQUIVALENTS AND FILE WRAPPER ESTOPPEL HAVE LONG BEEN RECOGNIZED BY THIS COURT.

There can be no unsettled question at this late date that a patentee may not equate his issued patent claims with those which he had cancelled and abandoned in order to induce the allowance of the issued claims. In *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U. S. 211 (1940), this Court stated:

> "... where the patentee in the course of his application in a patent office has, by amendment cancelled or surrendered claims, those which are allowed are to be read in the light of those abandoned and an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed. ... " [At page 218.]
>
> * * * * *
>
> "It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover that which was eliminated from the patent ... The patentee may not by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer ... The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest. ..." [At pages 220-221.]

These doctrines were re-affirmed in this Court's recent opinion in *Graham* v. *John Deere Company of Kansas City*, 383 U. S. 1 (1966):

> "Here, the patentee obtained his patent only by ac-

cepting the limitations imposed by the Examiner. The claims were carefully drafted to reflect those limitations and Cook Chemical is not now free to assert a broader view of Seoggin's invention." [At page 34.]

The instant case falls squarely under this unequivocal and long standing rule of law. Wagner eliminated the one-step cooking method claims and accepted the limitations imposed by the Examiner by presenting narrowed claims drawn only to a two-step cooking method. The lower Courts correctly held that Petitioners were estopped to broaden the Wagner claims in suit and that the one-step method claims surrendered by disclaimer could not be regained by recourse to the doctrine of equivalents. (Supp. App. to Pet., p. 17.)

III.

THERE IS NO CONFLICT OF DECISION INVOLVED UNDER THE FACTS OF THIS CASE.

Petitioners have argued that the Courts have not agreed upon the application of file wrapper estoppel where the claims are amended to overcome a Patent Office rejection based upon reasons other than prior art. (Pet., p. 12.) In reply, it first is noted that such a distinction that file wrapper estoppel is applicable in some instances but not in others has never been recognized or asserted by the Supreme Court. Rather, the Court has, in consistent and unequivocal holdings, stated that the allowed claims of a patent cannot by construction be read to cover claims which were rejected and cancelled. The Supreme Court never has recognized any exception to exist where the cancelled claims were rejected for indefiniteness rather than for prior art. To the contrary, these rules apply in all instances to prevent the injurious consequences which would result if patentees were permitted to revive cancelled claims and restore them to their patents.

Further, the alleged conflict between the Tenth Circuit case of *McCullough Tool Co.* v. *Well Surveys, Inc.*, 343 F. 2d 381 (1965) and the Seventh Circuit case of *Powder Power Tool Corp.* v. *Powder Actuated Tool Co.*, 230 F. 2d 409 (1956) does not stand up under careful analysis of these opinions. The supposed conflict between these cases was carefully considered by the First Circuit in *Borg-Warner Corp.* v. *Paragon Gear Works, Inc.*, 355 F. 2d 400 (1965), and that court held that "there is no real conflict, except linguistic" between these decisions. In fact situations where the patentee did not abandon anything, of course, the doctrine of file wrapper estoppel did not apply. However, in cases, like the one at bar, where originally claimed subject matter was abandoned in favor of newly claimed, more narrow, subject matter, the patentee was clearly estopped from recapturing the abandoned material.

Of particular importance here is the First Circuit's refusal to recognize any distinction based upon the nature of the Patent Office rejection, whether on prior art or indefiniteness or for any other ground:

> "If an applicant who accedes to a demand based upon the prior art is thereafter estopped to contest its necessity, he should equally be estopped to deny the correctness of a demand for which some other reason is given. To a party examining the file to determine the true scope of what has been granted, and finding something affirmatively disclaimed, it should make no difference what was the purpose of the disclaimer." [At page 406.]

In the present case, it is undisputed that the Wagner patent involves claims for a two-step cooking method which were obtained only after the patentee cancelled the rejected claims covering a one-step cooking method. Under these facts, all of the authorities are in agreement that Petitioners are estopped to now broaden the patent claims to cover the

subject matter of the abandoned claims. This is not a case where the patentee abandoned nothing and therefore is entitled to the doctrine of equivalents.

There is no conflict of decision or unsettled question of federal law for this Court to review.

CONCLUSION.

For the foregoing reasons it is submitted that the Petition should be denied.

Respectfully submitted,

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